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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/288,877 04/09/99 MCSHANE C 08215/301001

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IM22/1230

EXAMINER

SKANE, C


ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/288,877	Applicant(s) McShane et al	
	Examiner Christine Skane	Group Art Unit 1751	

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 1-14 and 35-37 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 15-34 and 38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-38 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Response to Amendment

Claim Rejections - 35 USC § 112

The rejection of claims 16 and 33-34 under 35 USC 112 is withdrawn in view of applicant's amendment.

Response to Arguments

1. Applicant's arguments filed 5-8-2000 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

1. Claims 15-23, 26, 28-29, 31 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese patent 61-260,503.

Applicant argues that JP '503 does not teach or suggest the claimed dielectric fluid because it includes a polymeric additive that is excluded by the presently claimed invention.

The examiner contends that said polymeric additive is not precluded by the transitional phrase "consisting essentially of" because said additive is not deleterious to the claimed composition, absent showing to the contrary.

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Moreover, it is held that when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of

"consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

2. Claims 15-23, 28-31 and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Maier and de Sio.

Applicant argues that Maier includes a halogenated hydrocarbon in its dielectric fluid and the presently claimed invention does not include halogenated compounds.

The examiner respectfully disagrees because the claims, as presently written, only require that the "... Vegetable oil is substantially free of chlorinated compounds" not the dielectric fluid composition. Therefore, the inclusion of additional components such as halogenated hydrocarbons do not appear to affect the basic and novel characteristic of the claimed dielectric composition and Maier does not include a chlorinated vegetable oil.

Applicants argue that de Sio includes organic vegetable oils such as castor oil, which renders the material unsuitable for use in many electrical devices such as transformers and does not meet viscosity limitations of the claimed invention.

The examiner contends that with respect to the castor oil being unsuitable for many electrical applications, applicant has not shown any evidence or criticality to substantiate this argument. The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). With respect

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to the viscosity limitations, it is the examiner's opinion that the viscosity of castor oil would have been inherent to the compositions of applicant's absent a showing to the contrary.

Claim Rejections - 35 USC § 103

3. Claims 15-31 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al.

Applicant argues that Sato et al do include an aromatic additive, which is not taught by the prior art of record.

Again, applicant is reminded that it is held that when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

New Rejection

4. Claims 15-23, 28-31 and 38-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark "Insulating Material for Design and Engineering Practice".

Clark discloses insulating liquids for use in transformers, cables, capacitors, switches and circuit breakers. Clark further teaches that said liquids include vegetable oils (pg. 132).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is 703-308-3732. The examiner can normally be reached on Monday-Thursday and alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Nicholas Ogden
Primary Examiner
Art Unit 1751

no
July 24, 2000